

## REMARKS

This paper is responsive to the Final Office Action mailed on August 17, 2006. At the time the Office Action was mailed, claims 1-28 were pending. By way of the present response the Applicant has: 1) amended no claims; 2) added no claims; and 3) canceled no claims. As such, claims 1-28 remain pending. The Applicant respectfully requests reconsideration of the present application and allowance of all claims now presented.

### Rejections Under 35 U.S.C. § 102

Claims 1-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by Herz et al. (U.S. Patent No. 5,835,087, herein referred to as “Herz”). The Applicant submits that the rejections to claims 1-28 are improper. The Examiner’s remarks in the Final Office Action, responsive to Applicants’ arguments, do not withstand scrutiny, as explained below.

The Applicant maintains and incorporates by reference the reasons presented in the previous response, dated May 16, 2006, as to why the rejections are improper.

The Applicant respectfully requests that the Office consider the claimed relationships that exist between the elements and terms of the claims. The Applicant respectfully submits that such consideration will show that Herz does not anticipate any of claims 1-28. To anticipate a claim, a reference must teach every element of the claim and the **“elements must be arranged as required by the claim.”** (See MPEP 2131, emphasis added.) Herz does not anticipate claims 1-28 because, for each claim, Herz does not disclose the elements of the independent claims arranged as required by the claim, assuming *arguendo* Herz discloses all of the limitations in any independent claim.

In Herz, a system automatically constructs both a target profile for each target object as well as a target profile interest summary for each user. (See Herz, Abstract, emphasis added.) The target profile interest summary describes the user's interest level in various types of target objects. (See Herz, Abstract). The system evaluates the target profiles against the users' target profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to each user so that the user can select from among these potentially relevant target objects, which were automatically selected by this system from the plethora of target objects that are profiled. (Herz, Abstract.) The selected target objects are delivered to the user. (See e.g., Herz, Fig. 10; col. 5, lines 61-62; col. 6, line 61 – col. 7, line 46.)

Herz does not disclose or suggest the following elements of claim 1 arranged as recited in claim 1 (emphasis added):

“identifying the potential recipient as a suggested recipient of the communication based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient; and  
presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient.”

In the Final Office Action, the Office has interpreted the “target object” of Herz as the “recipient” of claim 1, citing language in Herz which indicates that the target object can include “email to receive, or another person to correspond with.” (Final Office Action, p. 12.) First, in the context of Herz, “email to receive” means that the target object can be email that the user receives; it does not mean that the target object is a recipient. The target object cannot be the recipient of the email, because the target object is the email itself in that case. Therefore, the

language in Herz indicating that the target object can be “email to receive” does not support an interpretation that the target object in Herz is the “recipient” of claim 1. Second, in the context of Herz, “another person to correspond with” means another person that the user can communicate with. If the Office’s understanding is that this other person to correspond with is the “recipient” of claim 1, the Applicant respectfully submits that, in Herz, this target object (the alleged recipient) is presented to the user after the system evaluates profiles of the target objects against the users' target profile interest summaries, not against the content of any communication the user (the alleged sender) may draft or send.

The Final Office Action states that “every message before send to receiver has to make a compose draft before ready for send out as also shown in the abstract of Herz.” (Final Office Action, p. 12.) The Office asserts that this indicates that Herz teaches the claimed invention. However, the Abstract of Herz indicates that the user selects from among target objects. The Abstract of Herz describes using automatically constructed target profile interest summaries to organize the distribution of information. The Abstract of Herz does not describe what is alleged by the Examiner. Indeed, the Abstract of Herz suggests operations contrary to the limitations of claim 1. The Abstract of Herz suggests that the entity that selects the target object (the user that allegedly selects the recipient) is not the same entity as the entity that does the sending, i.e., is not the sender. Rather, in Herz, some other entity (a source of the target object, e.g., a marketer) sends the target object to the entity that does the selecting (the user). (*See e.g.*, Herz, col. 2, lines 29-39; col. 5, lines 61-64; col. 7, lines 15-25.)

Furthermore, regardless of whether the Abstract describes what is asserted, claim 1 requires more than just a sender composing a draft of a communication before transmission of the communication. Claim 1 requires “presenting the suggested recipient to a sender of the

communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient” (emphasis added), for example. Herz does not disclose this.

First, as stated, in Herz, the entity (the user) that is presented with target objects (the alleged recipient) for selection is not “a sender of the communication.” In claim 1, “the communication” has a specific relationship to other claim terms. The relationship between “the communication” and other claim terms is indicated by the limitations of claim 1 of: “an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient” and “the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient” (emphasis added). The user in Herz is not a sender of “the communication,” as required by claim 1.

Second, in Herz, the suggested target object (the alleged recipient) is not presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient. The Office maintains that Herz discloses an evaluation of a correspondence between content of profiles of potential recipient and content of a communication in col. 5, lines 7-20 and col. 18, lines 17-36. (Office Action, p. 12.) The Final Office Action states that Herz clearly shows an evaluation. However, claim 1 requires more than just any evaluation. Claim 1 requires “an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient.” Herz does not disclose or suggest this.

Col. 5, lines 7-20 of Herz recites (emphasis added):

The system for electronic identification of desirable objects of the present invention automatically constructs both a target profile for each target object in the electronic media based, for example, on the frequency with which each word appears in an article relative to its overall frequency of use in all articles, as well as a "target profile interest summary" for each user, which target profile interest summary describes the user's interest level in various types of target objects. The system then evaluates the target profiles against the users' target profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to each user so that the user can select from among these potentially relevant target objects, which were automatically selected by this system from the plethora of target objects available on the electronic media.

Col. 5, lines 7-20 of Herz does not describe "an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient." In order to assert that col. 5, lines 7-20 of Herz discloses this limitation, the Office must be interpreting the users' target profile interest summaries as "the communication" of claim 1 since the Office's has interpreted the target object as the "recipient" of claim 1. However, as discussed above, the users' target profile interest summaries of Herz are not the "communication" claim 1. In Herz, the users' target profile interest summaries are automatically constructed. (See Herz, Abstract). Additionally, in Herz, the users' target profile interest summaries are not for transmission to the alleged recipient (the target object).

Col. 18, lines 17-36 of Herz recites (emphasis added):

Relevance feedback only determines the user's interest in certain target objects: namely, the target objects that the user has actually had the opportunity to evaluate (whether actively or passively). For target objects that the user has not yet seen, the filtering system must estimate the user's interest. This estimation task is the heart of the filtering problem, and the reason that the similarity measurement is important. More concretely, the preferred embodiment of the filtering system is a news clipping service that periodically presents the user with news articles of potential interest. The user provides active and/or passive feedback to the system relating to these presented articles. However, the system does not have feedback information from the user for articles that have never been presented to the user, such as new articles that have just been added to the database, or

old articles that the system chose not to present to the user. Similarly, in the dating service domain where target objects are prospective romantic partners, the system has only received feedback on old flames, not on prospective new loves.

Col. 18, lines 17-36 of Herz also does not describe “an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient.” The evaluation described in col. 18, lines 17-36 of Herz is an evaluation made by a user who sees a target object, in this case, a news article. Col. 18, lines 17-36 of Herz suggests that the user in Herz views a target object and evaluates it to provide feedback to the system, allowing the system to estimate the user’s interest in other target objects. The evaluation described in col. 18, lines 17-36 of Herz is not between content of a communication, a draft of which the user (the alleged sender) composes, and content of a profile of the target object (the alleged recipient).

Herz does not disclose or suggest the elements of claim 1, arranged as recited in the claim and having the relationships between the terms as recited in the claim. Accordingly, the Applicant respectfully submits that claim 1 is patentable over Herz.

Similar arguments are applicable to independent claims 14, 27 and 28. Accordingly, the Applicant respectfully submits that independent claims 14, 27 and 28 are also patentable over Herz. The remaining claims depend directly or indirectly from one of the foregoing independent claims. Therefore, the Applicant respectfully submits the remaining claims are also patentable over Herz.

Conclusion

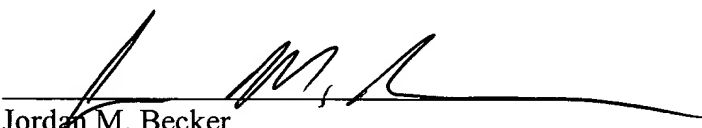
The Applicant respectfully submits the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Jordan Becker at (408) 720-8300.

Pursuant to 37 C.F.R. 1.136(a)(3), the Applicant hereby requests and authorize the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,

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